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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/772,221

02/04/2004

Michael John Brady

38381DR1B

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7590

02/09/2005

John H. Sherman, c/o Legal Department  
Intermec Technologies Corporation  
550 Second Street, SE  
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EXAMINER

LEE, BENJAMIN C

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/772,221

Applicant(s)

BRADY ET AL.

Examiner

Benjamin C. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Status*

1. Claims 9-49 are pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 24-25, 28-29, 33-34, 38 and 49 are rejected under 35 U.S.C. 102(e) as being anticipated by Alicot et al. (US pat. #5,859,587).

#### 1) Regarding claims 24-25, 28-29, 33-34, 38:

Alicot et al. discloses the claimed apparatus (Fig. 1) comprising: (a) a radio frequency tag including an integrated circuit package/chip (20) containing at least tag electronic circuitry, a tag power supply integrated with said tag electronic circuitry (inherent, either a battery or capacitor), and a tag antenna (22) operatively coupled to the integrated circuit package (Fig. 1); (b) a non-linear magnetic material (16 and col. 2, lines 57-63, whereby Barkhausen jump type magnetic

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material, for example, are non-linear) providing an article surveillance (EAS) response in the presence of an interrogating field; and (c) the radio frequency tag communicating information by modulating reflectance characteristics of the tag antenna, wherein the integrated circuit package comprises a semiconductor device (inherent of 20) containing the tag electronic circuitry and the tag power supply, and the tag antenna comprises an antenna element electrically connected to the semiconductor device (Fig. 1).

2) Regarding claim 49, Alicot et al. met all of the claimed subject matter as in claim 38, including:

--the claimed wherein the tag antenna comprises an electrically conducting wire antenna (16) electrically connected to a semiconductor device (20) incorporating the tag electronics, wherein the tag antenna and the semiconductor device are attached to a dielectric material (12) and wherein the non-linear magnetic material is attached to the dielectric material (Fig. 1).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11, 13, 15, 26-27, 36-37 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alicot et al. in view of Gunnarsson (US pat. #5,552,790).

1) Regarding claim 11:

Alicot et al. discloses all of the claimed subject matter as in the consideration of claims 24-25 above, wherein the magnetic material is attached to the tag body support/substrate (Fig. 1 and col. 2, lines 1-9), while:

Gunnarsson discloses a tag with antenna construction in which the tag antenna comprises a patch antenna formed by a dielectric sheet (17) having a first side and a second side, a first electrically conducting material (16) attached to the first side, and a second electrically conducting material attached to the second side, wherein the semiconductor device is electrically connected to the first electrically conducting material and the second electrically conducting material, whereby the dielectric sheet (17) constitutes the tag body support/substrate (Fig. 2b).

In view of the teachings by Alicot et al. and Gunnarsson, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention to implement the RF tag portion of the apparatus of Alicot et al. using a known patch antenna using the construction as taught by Gunnarsson based on the desired frequency range of operation of patch antennas suited for intended applications, whereby the EAS magnetic material to be attached to the tag body support/substrate would then be attached to the dielectric sheet.

2) Regarding claims 13 and 15, Alicot et al. and Gunnarsson render all of the claimed subject matter obvious as in the consideration of claim 11 above in view of Gunnarsson.

3) Regarding claims 26-27, Alicot et al. met all of the claimed subject matter as in claims 24-25, plus the obviousness consideration of claim 11 above in view of Gunnarsson.

4) Regarding claims 31-32, Alicot et al. met all of the claimed subject matter as in claim 28, plus the obviousness consideration of claim 11 above in view of Gunnarsson.

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5) Regarding claims 36-37, Alicot et al. met all of the claimed subject matter as in claim 33, plus the obviousness consideration of claim 11 above in view of Gunnarsson.

6) Regarding claim 48, Alicot et al. met all of the claimed subject matter as in claim 38, plus the obviousness consideration of claim 11 above in view of Gunnarsson.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 38-49 are rejected under the judicially created doctrine of double patenting over claims 1-11 of U. S. Patent No. 5,939,984 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claims 38-49 correspond to, and are met by patented claims 1-11, respectively. Note that the only difference between the current claims and patented claims are "non-linear magnetic material operably associated with." versus "non linear magnetic material connected with.".

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Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

8. Claims 9-37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 9-10 of U.S. Patent No. 5,939,984. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

1) Regarding claims 9, 10, 11, 12, 13, 14, 15, 16-18, 19, 20-22, 23, 24-26, 27, 28-31, 32, 33-36, and 37, patented claims 7, 9, 10, 9, 10, 7, 10, 9, 9-10, 9, 9-10, 9, 10, 9, 10, 9, and 10, respectively, disclose all of the claimed subject matter, except specifying the claimed integrated circuit/package/chip and integrated tag power supply. However, it would have been obvious to one of ordinary skill in the art at the time of the claimed invention that the RF transponder/tag apparatus having electronics including memory and communications capability of patented claim 7 relies upon conventional RF transponder construction detail where not specified, whereby conventional RF transponder construction comprises such claimed features including integrated circuit/package/chip and integrated tag power supply.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Gnadinger et al., US pat. #6,268,796

--A similar RFID transponder with integrated antenna having magnetic material.

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2) Tyren, US pat. #5,576,693

--A similar tag with affecting magnetic material.

3) Pichl, US pat. #5,392,028

--A similar combined electronic and EAS magnetic tag.

4) Nikolich, US pat. #5,986,562

--A similar RFID device with magnetic printed tag.

5) Montean, US pat. #4,745,401

--A similar RF tag with EAS magnetic material.

6) Veghte et al., US pat. #5,771,021

--A known use of patch antenna for transponder.

7) Tuttle, US pat. #6,339,385

--A RFID tag with conventional circuit, antenna and substrate construction.

8) Moskowitz et al., US pat. #5,528,222

--Another RFID tag with conventionally known construction.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin C. Lee whose telephone number is (571) 272-2963.

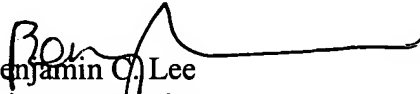
The examiner can normally be reached on Mon -Fri 11:00Am-7:30Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin C. Lee  
Primary Examiner  
Art Unit 2632

B.L.